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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/481,196  | 01/11/2000  | PAUL MATTHEW PIRILLO | 8461                | 5306             |
| 26884   | 7590        | 06/15/2004           | EXAMINER            |                  |
| PAUL W. MARTIN<br>LAW DEPARTMENT, WHQ-4<br>1700 S. PATTERSON BLVD.<br>DAYTON, OH 45479-0001 |             |                      | GART, MATTHEW S     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3625                |                  |

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/481,196

Applicant(s)

PIRILLO, PAUL MATTHEW

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-10,13-18 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,11,12,19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2,5-10,13-18 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

In view of the Appeal Brief filed on February 11, 2004, PROSECUTION IS HEREBY REOPENED. A new ground for rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claims 1-2, 5-10, 13-18 and 21-24 are pending in the instant application. Claims 3-4, 11-12 and 19-20 have been previously canceled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 5-10, 13-18 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 6,129,274) in view of Heutschi (U.S. Patent No. 6,335,678).**

Referring to claim 1. Suzuki discloses a self-service terminal comprising:

- A customer information interface for receiving consumer information from a customer contact device and a central repository including purchase and usage patterns (Suzuki, Abstract, "Demographic profile data, a customer's transaction history data and a customer's current incentive indicia are stored in particular locations in a memory of a portable, machine-readable smart card. The smart card is adapted to interface with a store's check-out terminals and customer assistance, or kiosk terminals."); and
- A processor for receiving the customer information, using the customer information to identify customer preferences, generating customer information displays based on customer preferences and purchase the usage patterns, generating customer selectable options based on the received customer information, receiving customer selections and processing financial transactions and data transfers based on the customer selections (Suzuki, column 5, line 61 to column 6, line 52)

Suzuki does not expressly disclose a self-service terminal for allowing customer download of electronic media comprising:

- A customer input interface including a display for communicating information to a customer describing available options and choices, the customer input interface

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allowing input from a customer, the customer input interface allowing a customer to select electronic media for purchase;

- A data acquisition interface for acquiring customer selected electronic media for transfer to the customer; and
- A data transfer interface for transferring customer selected electronic media to the customer contact device.

Heutschi discloses a self-service terminal for allowing customer download of electronic media comprising:

- A customer input interface including a display for communicating information to a customer describing available options and choices, the customer input interface allowing input from a customer, the customer input interface allowing a customer to select electronic media for purchase (Heutschi: column 3, lines 38-56);
- A data acquisition interface for acquiring customer selected electronic media for transfer to the customer (Heutschi: column 4, lines 15-39); and
- A data transfer interface for transferring customer selected electronic media to the customer contact device (Heutschi: column 3, lines 38-56 and column 4, lines 15-39).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Suzuki to have included the limitations of Heutschi as discussed above because experience shows that only simple and user-friendly devices have long-term success in use and in sales (Heutschi: column 1, lines 23-29).

Referring to claim 2. Suzuki further discloses the terminal wherein the data transfer interface includes a download cradle adapted to connect with an electronic book reader to provide a connection for the transfer of information and the electronic book reader (Suzuki: Figure 1).

Referring to claim 5. Suzuki further discloses the terminal wherein the download cradle is adapted to read customer information from the electronic book reader and wherein the customer information interface includes the download cradle (Suzuki: column 4, lines 37-58, "The portable machine-readable personal memory store is used in conjunction with at least a point-of-sale check-out type terminal which includes a personal memory store interface unit capable of reading, writing and editing demographic profile, transaction history and incentive indicia information of a personal memory store. The terminal further includes an output device and a microprocessor based control unit coupled between the interface unit and the output device.").

Referring to claim 6. Suzuki further discloses the terminal wherein the customer information interface further includes a smart card reading and writing device for reading customer information from and writing data to a smart card and wherein the data transfer interface also includes the smart card reading and writing device, the smart card reading and writing device being adapted to receive data from and transfer data to the terminal (Suzuki: column 4, lines 37-58).

Referring to claim 7. Suzuki further discloses the terminal wherein the processor is adapted to retrieve the customer information and analyze the customer information to

determine customer preferences and to use the customer preference to develop purchase suggestion based on the customer preferences (Suzuki: abstract).

Referring to claim 8. Suzuki further discloses the terminal that is operative to cryptoprocess data for delivery to the electronic book reader (Suzuki: Figure 1 and Figure 5).

Referring to claim 9. Suzuki in view of Heutschi discloses a terminal according to claim 8 as indicated supra. Heutschi further discloses the terminal wherein the data transfer interface includes a compact disk recorder for recording software on a recordable compact disk (Heutschi: column 1, lines 7-15, "A known document EP-A 0390611 describes a book with a floppy disc as the memory. The mechanical part of this memory is sensitive to impacts, requires a great deal of space and is much too expensive. Consequently, these books are cumbersome and too bulky. In addition, one requires additional buttons for controls in order to operate the floppy disc.").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Suzuki to have included the limitations of Heutschi as discussed above because experience shows that only simple and user-friendly devices have long-term success in use and in sales (Heutschi: column 1, lines 23-29).

Referring to claims 10 and 13-17. Claims 10 and 13-17 are rejected according to claims 1, 2 and 5-9 as indicated supra.

Suzuki further discloses a system including an advertising server wherein the terminal support manager is operable to retrieve advertising from the advertising server

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and to supply the advertising to the terminal, and wherein the terminal is operative to selectively display advertising based on customer information contact information (Suzuki: column 1, lines 58-56, "An additional use of customer transaction information is to maintain a shopping history record of purchases by particular customers so as to award loyalty or incentive points to a customer based on their transactions. For example, incentive points might qualify a customer for participation in a discount program or some similar promotion, in a manner similar to airlines awarding frequent-flyer mileage points.").

Heutschi further discloses a system wherein the terminal is operative to connect to a network adapted to provide remote audio and video communication (Heutschi: column 2, lines 35-42).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Suzuki to have included the limitations of Heutschi as discussed above because experience shows that only simple and user-friendly devices have long-term success in use and in sales (Heutschi: column 1, lines 23-29).

Referring to claims 18 and 21. Claims 18 and 21 are rejected according to claims 1, 2 and 5-9 as indicated supra.

Heutschi further discloses a method wherein the advertising content and the centrally stored customer information are processed to generate a java applet (Heutschi: column 5, line 60 to column 6, line 11).



At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Suzuki to have included the limitations of Heutschi as discussed above because experience shows that only simple and user-friendly devices have long-term success in use and in sales (Heutschi: column 1, lines 23-29).

Referring to claims 22 and 23. Suzuki in view of Heutschi discloses a terminal according to claim 1 as indicated supra. Heutschi further discloses a loudspeaker and wherein the customer input interface further comprises a microphone for conferencing the customer with a remote help desk operator (Heutschi: column 2, lines 35-42).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Suzuki to have included the limitations of Heutschi as discussed above because experience shows that only simple and user-friendly devices have long-term success in use and in sales (Heutschi: column 1, lines 23-29).

Referring to claim 24. Suzuki in view of Heutschi discloses a terminal according to claim 1 as indicated supra. Heutschi further discloses the terminal wherein the electronic media comprises an electronic book (Heutschi: abstract).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Suzuki to have included the limitations of Heutschi as discussed above because experience shows that only simple and user-friendly devices have long-term success in use and in sales (Heutschi: column 1, lines 23-29).

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***Response to Arguments***

Applicant's arguments with respect to claims 1-2, 5-10, 13-18 and 21-24 have been considered but are moot in view of the new ground(s) of rejection.

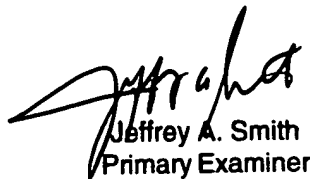
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG  
June 9, 2004

  
Jeffrey A. Smith  
Primary Examiner  
Acting SPE  
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